



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/534,082 | 12/12/2005 | Shuji Hinuma | 68137(46342) | 9415 |
| 21874 | 7590 | 05/05/2009 | | |
| EDWARDS ANGELL PALMER & DODGE LLP | | | EXAMINER | |
| P.O. BOX 55874 | | | SWARTZ, RODNEY P | |
| BOSTON, MA 02205 | | | | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1645 | | |
| | | MAIL DATE | DELIVERY MODE | |
| | | 05/05/2009 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,082

Applicant(s)

HINUMA ET AL.

Examiner

Rodney P. Swartz, Ph.D.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28, 60 and 62-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13, 15-18, 20-23, 25, 27, 28, 60, 62-71 and 73 is/are allowed.
- 6) ☒ Claim(s) 14, 19, 24, 26 and 72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 December 2009 has been entered.
2. Claims 1, 2, 6, 7, 12, 13, 14, 15, 16, 22, 23, 27, 28, 60, 62, 66, 70 and 72 have been amended. Claim 58 has been cancelled.
3. Claims 1-28, 60 and 62-73 are pending and under consideration.

Rejections Moot or Withdrawn

4. The rejection of claim 58 under 35 U.S.C. 112, first paragraph, scope of enablement, is moot in light of the cancellation of the claim.
5. The objection to claim 14 is withdrawn in light of the amendment of the claim.
6. The rejection of claim 58 under 35 U.S.C. 112, second paragraph, as being indefinite for components of kit, is moot in light of the cancellation of the claim.
7. The rejection of claims 1, 2, 6, 7, and 10-14 under 35 U.S.C. 112, second paragraph, as being indefinite for "optionally formylated" is withdrawn in light of the amendments of the claims.
8. The rejection of claims 15-23 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn in light of the amendments of the claims.
- 9.
10. The rejection of claim 27 under 35 U.S.C. 112, second paragraph, as being indefinite for components of kit, is withdrawn in light of the amendments of the claims.

11. The rejection of claim 28 under 35 U.S.C. 112, second paragraph, as being indefinite for components of kit, is withdrawn in light of the amendments of the claims.
12. The rejection of claim 60 under 35 U.S.C. 112, second paragraph, as being indefinite, is withdrawn in light of the amendments of the claims.
13. The rejection of claim 62, 65-69, and 73 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for optionally formulated, is withdrawn in light of the amendments of the claims.
14. The rejection of claim 70 under 35 U.S.C. 112, second paragraph, as being indefinite, is withdrawn in light of the amendments of the claims.
15. The rejection of claim 71 under 35 U.S.C. 112, second paragraph, as being indefinite, is withdrawn in light of the amendments of the claims.
16. The rejection of claim 72 under 35 U.S.C. 112, second paragraph, as being indefinite, is withdrawn in light of the amendments of the claims.

Claim Rejections - 35 USC § 112

17. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is a period in line 5 following "viral infection" indicating the end of the claim. However, there is more recitation after the period. It is unclear where the claim ends.

18. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is a period in line 5 following "viral infection" indicating the end of the claim. However, there is more recitation after the period. It is unclear where the claim ends.

19. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is a period in line 3 of section "(B)" following "NO:2" indicating the end of the claim. However, there is more recitation after the period. It is unclear where the claim ends.

20. Claim 72 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Line 3 of section "(A)" contains "amino acid sequence pf SEQ ID NO:12". Clarification is required for "pf".

21. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim depends from a rejected claim.

Conclusion

22. Claims 14, 19, 24, 26 and 72 are rejected.

23. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571) 272-0865. The examiner can normally be reached on Monday through Wednesday from 9:00 AM to 7:30 PM EST. Thursday is the examiner's work at home day.

If attempts to reach the Examiner by telephone are unsuccessful, please contact the Examiner's Supervisor, Robert B. Mondesi (571)272-0956.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rodney P. Swartz, Ph.D./

Primary Examiner, Art Unit 1645

May 1, 2009